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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,797	05/30/2000	Peter C. Iwen	UNMC-Iwen	1242

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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT PAPER NUMBER

1634

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/580,797

Applicant(s)

IWEN ET AL.

Examiner

Jeanine A Goldberg

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 21 January 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.


NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 22.Claim(s) objected to: NONE.Claim(s) rejected: 2-5, 20 and 21.Claim(s) withdrawn from consideration: NONE.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. ☐ Other: _____


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Continuation of 5. does NOT place the application in condition for allowance because:

First, As provided by MPEP 716.01, Declarations filed under 1.132 are considered timely filed if filed prior to a final rejection.

"The following criteria are applicable to all evidence traversing rejections submitted by applicants, including affidavits or declarations submitted under 37 CFR 1.132: (A) Timeliness. Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted: (1) prior to a final rejection...."

However, in an effort to expedite prosecution, the examiner reviewed the instant declaration.

The request for reconsideration and the declaration filed by Dr. Iwen have been thoroughly reviewed, but found not persuasive to overcome the 103 rejection of record. The 103 rejection cites, as the closest prior art, the primers of White, namely ITS5 and ITS4. As previously noted SEQ ID NO: 1 of the instant application is identical to ITS5 taught by White.

As provided by MPEP 716.02(e), "An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. In re Burckel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." In re Merchant, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978) (emphasis in original). Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, In re Finley, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant, explanation should be required. In re Armstrong, 280 F.2d 132, 126 USPQ 281 (CCPA 1960) (deviations from example were inconsequential).

The declaration does not compare the claimed SEQ ID NO: 1 and 2 to the closest prior art, namely SEQ ID NO: 1 (ITS5) and ITS4. Since the forward primer is taught in the art, a comparison without this primer is not the closest prior art. The declaration teaches SEQ ID NO: 1 and 2 have unexpected results over ITS1 and ITS4 taught by White. However, this comparison is not directed to SEQ ID NO: 1 (ITS5) and ITS4. The results of the declaration fail to show that not all primers within the 28S region are equivalents. Therefore, the proposed unexpected results are insufficient to overcome the rejections of record.

With respect to the arguments, the applicants traverse the rejection because the claims requires primers consisting of SEQ ID NO: 1 and 2, however the art fails to teach SEQ ID NO: 2. This argument is not persuasive because the rejection is not based on 102, but rather 103 obviousness.

The response asserts that there is no motivation to select the particular primer. This argument has been considered, but not persuasive for the reasons already of record. Each of the primers which are located in the 28S conserved region are functional equivalents.